

## **REMARKS**

Claims 1-6 and 8, 10 remain in the application. Claim 9 has been canceled.

Independent claim 1 has been amended to include the limitations of a surfactant comprising an ethoxylate ether. Support for this amendment can be found on page 8, paragraph 1 of the present application, for example. Claim 10 has been amended for clarity. No new subject matter has been added with these amendments.

### A. 35 U.S.C. § 112

Claims 1-6 and 8-10 have been rejected under section 112, first paragraph. Claim 1 has been amended to overcome the rejection. Thus, reconsideration and withdrawal of the Section 112 rejection of claims 1-6, 8, 10 is respectfully requested

### A. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-6, 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Kato (Office Action, page 3). The Office contends (to which Applicants do not concede) that it would have been obvious to use the abrasive range of Kato in the slurry of Wang. However, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA

1974). Claim 1 has been amended to include the limitations of a surfactant comprising an ethoxylate ether. Because neither Wang nor Kato teach or even suggest the limitations of amended claim 1, claim 1 is not rendered obvious by Wang in view of Kato. Because the dependent claims are not obvious for at least the same reasons as the independent claims from which they depend, the dependent claim rejections will not be addressed at this time. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claims 1-6 and 8 is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Kato and further in view of Sachans (Office Action, page 5). The Office contends (to which Applicants do not concede) that it would have been obvious to use the CTAH of Sachans in the slurry of Wang, Kato. However, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 1 has been amended as above. Because Wang, Kato nor Sachans teach or even suggest the limitations of amended claim 1, claim 10 which depends on claim 1 is not rendered obvious by Wang in view of Kato and Sachans. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 10 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (480) 715-5488.

Respectfully submitted,

/Kathy J. Ortiz/

Kathy J. Ortiz

Reg. No. 54,351

Attorney for Applicants

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